

Serial No. 10/691,974
Docket No. IPB.010
Amendment

Amendments to the Drawings:

One attached sheet of drawing changes the numeral indicating the glazing element from “12” to “13” in Fig 4. The other corrects the lead line from “200” in Fig. 9 to indicate the nail.

Attachments: Two Replacement Sheets

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REMARKS

Information Disclosure Statement

The present application is a continuing application of Serial No. 09/803,669, filed on March 12, 2001, which is now US Patent No. 6,640,508. All of the references mentioned in the specification of the present application, as well as other references, are listed on the patent as having been cited in that case. The pertinent section of the MPEP is:

609.02 Information Disclosure Statements in Continued Examinations or Continuing Applications [R-5]

>When filing a continuing application that claims benefit under 35 U.S.C. 120 to a parent application (other than an international application that designated the U.S.), it will not be necessary for the applicant to submit an information disclosure statement in the continuing application that lists the prior art cited by the examiner in the parent application unless the applicant desires the information to be printed on the patent issuing from the continuing application (for continued prosecution applications filed under 37 CFR 1.53(d), see subsection A.1. below). The examiner of the continuing application will consider information which has been considered by the Office in the parent application.

The applicants desire the information to be printed on the patent issuing from the present continuing application and, therefore, submit herewith a list of the references cited in the parent. It is respectfully requested that the Examiner acknowledge consideration of all of the references and arrange for a list of the references to be printed on the patent issuing from the present continuing application.

Drawings

Two replacement sheets correcting the errors pointed out by the Examiner are submitted herewith.

Specification

The reference numeral “143a” has been changed to “134a” on page 7, line 26.

Claim Objections

“Upward” has been changed to “upwardly” in claims 3, 4, 8 and 9.

With respect to “substantially”, the MPEP says:

2173.05(b) Relative Terminology [R-5]

D. "Substantially"

The term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988).

Accordingly, “substantially”, although broad, is definite. Similarly, “generally” is definite.

Claim Rejections

Reconsideration of the rejection of claim 1 under 35 USC 102 as being anticipated by the Chambers reference is respectfully requested. By the present Amendment, claim 1 has been amended to recite that the flashing component comprises four interconnected sides defined by a first plurality of flashing members of a substantially rigid material, wherein two of said four sides are longer than the other two sides, and a flashing member of a resiliently foldable material connected with each of the flashing members of a substantially rigid material that define the two

longer sides, no flashing member of a resiliently foldable material being connected with either of the flashing members of a substantially rigid material that define said other two sides. Thus, claim 1 calls for a flashing member of a resiliently foldable material to be connected with only the members of a substantially rigid material that define the two longer sides, not with the members of a substantially rigid material that define all of the sides.

In contrast, Chambers fails to disclose either 1) the four interconnected sides, 2) two of the four sides being longer than the other two sides, or 3) a flashing member of a resiliently foldable material being connected with each of the flashing members of a substantially rigid material that define the two longer sides, and no flashing member of a resiliently foldable material being connected with either of the flashing members of a substantially rigid material that define said other two sides. In Chambers, the resilient material is connected with any and all sides defined by its first member 12.

Furthermore, claim 1 has been amended to recite that the four sides together define an opening through the flashing component, wherein said opening is adapted to receive the main frame component of a roof window assembly. This can be appreciated from, for example, Figs. 3-6 of the present application.

In contrast, the sides defined by the member 12 of Chambers are at the edges of the roof. Thus, they are not adapted to receive the main frame component of a roof window assembly. In addition, the sides defined by the member 12 each have a main portion extending at an angle toward another side, and each have a flexible second member extending farther toward another

side. At least the main metallic portion extending at an angle toward another side and the flexible second member extending farther toward another side make the structure of Chambers not adapted to receive the main frame component of a roof window assembly. Of course, the positioning of the sides 12 of Chambers at the edges of a roof also make the sides spaced too far from one another to receive the main frame component of a roof window assembly and, thus, make the structure of Chambers not adapted to receive the main frame component of a roof window assembly.

It is pointed out that “adapted to” imparts a structural limitation to the claim and that such a limitation must be considered. In this regard, the applicants point to *In re Venezia*, 189 USPQ 149 (CCPA 1976), in which the court referred to the claim language “a pair of sleeves *** each sleeve of said pair *adapted to be fitted* over the insulating jacket of one of said cables” and stated: “Rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured or dimensioned that it can be fitted over the insulating jacket of a cable. A similar situation exists with respect to the ‘adapted to be affixed’ and ‘adapted to be positioned limitations’ of the third and fourth paragraphs of the claim.” Thus, the subject recitation of, for example, claim 1 here, namely, “wherein said opening is adapted to receive said main frame component of a roof window assembly”, imparts a structural limitation to the claim, and such a limitation must be considered.

Further with respect to “adapted to”, Judge Rich dealt with the following “adapted to” language of claims 70 and 71 in the case of *In re Land and Rogers*, 151 USPQ 621,636-637 (CCPA 1966): “* * * said color-providing substances associated with at least the inner

photosensitive emulsion layers are *adapted to be rendered diffusible* in said liquid composition *only after at least substantial development* of the next outermost photosensitive * * * layer has occurred”, in which the italics were by the court. Of this claim language he said: “It is true that the italicized portions are "functional" but we do not regard that as good ground to give them "no weight" in view of the third paragraph of 35 USC 112. We give them weight and with this limitation we think claims 70 and 71 are limited to deferred diffusion *built into the structure recited*, thereby being limited to the actual invention disclosed and hence allowable for the same reasons given by the board in allowing claim 56, of which it said: ‘In our view the art of record as applied by the Examiner does not suggest the process of this claim.’ We think the same reasoning applies to the product.” Again, the italics were by the court.

Similar to the claim language of *In re Land and Rogers*, the ability “wherein said opening is adapted to receive said main frame component of a roof window assembly” in the claims of the present application is built into the structure recited, that is, the ability is built into the four interconnected sides defined by a first plurality of flashing members. That ability recited in claim 1 is not disclosed in Chambers.

Reconsideration of the rejection of claims 2 and 4 under 35 USC 103 as being unpatentable over the Chambers reference in view of the Verby et al. reference is also respectfully requested. Since claims 2 and 4 both depend on claim 1, they both recite that the flashing component comprises four interconnected sides defined by a first plurality of flashing members of a substantially rigid material, wherein two of said four sides are longer than the other two sides, and a flashing member of a resiliently foldable material connected with each of

the flashing members of a substantially rigid material that define the two longer sides, no flashing member of a resiliently foldable material being connected with either of the flashing members of a substantially rigid material that define said other two sides.

Like Chambers, Verby et al. fails to disclose a flashing member of a resiliently foldable material being connected with each of the flashing members of a substantially rigid material that define the two longer sides, and no flashing member of a resiliently foldable material being connected with either of the flashing members of a substantially rigid material that define said other two sides. In fact, Verby et al. discloses no flashing member of a resiliently foldable material at all. As a result, even if Chambers and Verby et al. were combined in the manner set forth by the Examiner, there would be no disclosure of a flashing member of a resiliently foldable material being connected with only the flashing members of a substantially rigid material that define the two longer sides of four sides and, thus, the combination would fail to contain all of the features of claims 2 and 4, as amended.

Reconsideration of the rejection of claims 6-9, 11-13, 15 and 16 under 35 USC 103 as being unpatentable over the Verby et al. reference in view of the Chambers reference is also respectfully requested. Like claim 1, independent claims 6 and 11 have been amended to recite that the flashing component comprises four interconnected sides defined by a first plurality of flashing members of a substantially rigid material, wherein two of said four sides are longer than the other two sides, and a flashing member of a resiliently foldable material connected with each of the flashing members of a substantially rigid material that define the two longer sides, no flashing member of a resiliently foldable material being connected with either of the flashing

members of a substantially rigid material that define said other two sides. Thus, claims 6 and 11, as amended, call for a flashing member of a resiliently foldable material to be connected with only the members of a substantially rigid material that define the two longer sides, and not with the members of a substantially rigid material that define all of the sides.

Like the combination of Chambers in view of Verby et al. discussed above, even if Verby et al. and Chambers were combined in the manner set forth by the Examiner against claims 6 and 11, the combination would fail to contain the recited flashing member of a resiliently foldable material being connected with each of the flashing members of a substantially rigid material that define the two longer sides, and no flashing member of a resiliently foldable material being connected with either of the flashing members of a substantially rigid material that define said other two sides. Verby et al. does not disclose any flashing member of a resiliently foldable material at all, and Chambers does not suggest that its resilient material be omitted from any of its first member 12. As a result, it would not have been obvious to connect a flashing member of a resiliently foldable material with only the flashing members of a substantially rigid material that define the two longer sides of four sides and, thus, the combination would fail to contain all of the features of claims 6 and 11, as amended.

Furthermore, it would not have been obvious, without the benefit of the disclosure of the present application, to connect flexible material like that of the second member 14 of Chambers to the flashing 30 of Verby et al. that is designed to be engaged with roof shingles 52 directly, without any intervening structure. It especially would not have been obvious, without the benefit of the disclosure of the present application, to connect flexible material like that of the second

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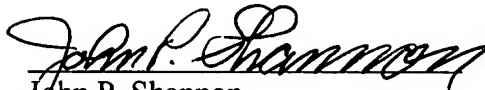
member 14 of Chambers to the sides of the flashing 30 of Verby et al., because additional flashing material on the sides of the flashing 30 would have covered the mounting brackets-22 that Verby et al. intend to keep uncovered.

In view of the foregoing, it is submitted that all of the claims are allowable and that the application is in condition for allowance. An early notice to that effect is respectfully requested.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0562.

Respectfully submitted,

Date: 7-3-07


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